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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,752	02/01/2005	Makoto Urushihara	263468US6PCT	9309
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
KHAN, ASHER R				
ART UNIT		PAPER NUMBER		
2621				
NOTIFICATION DATE		DELIVERY MODE		
10/06/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/522,752

Applicant(s)

URUSHIHARA ET AL.

Examiner

ASHER KHAN

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8, and 15-16 is/are rejected.
- 7) ☒ Claim(s) 4-7 and 9-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/US)
Paper No(s)/Mail Date 2/28/2008; 1/31/2008; 2/1/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

Allowable Subject Matter

Claims 4-7 and 9-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The present invention is directed to changing format of video tape to format of DVD. The dependent **claim 4** identifies the uniquely distinct features "wherein a first fixed value is predetermined as a maximum value among settable values of said first bit rate;
a second fixed value is predetermined as a maximum value among settable values of said second bit rate; and said setting means, if a first inequality expressed in
 $(B1 + B2) \times Tx < Cmax$
where Tx denotes a recording time of said content data checked by said checking means, B1 denotes said first fixed value, B2 denotes said second fixed value, and Cmax denotes a recordable maximum capacity of said recording medium of which recording is controlled by said recording control means, is found established, then sets said first fixed value as a value of said first bit rate and Said second fixed value as a value of said second bit rate." The closest prior arts "U.S. Patent No. 5,835,668" and "U.S. Patent Pub. 2003/0194008" fail to anticipate or render the above underlined limitations obvious.

Claims 5-7 are allowable as depending from allowable claim 4.

The dependent **claim 9** identify uniquely distinct features "computation means for computing a free capacity of said storage means;
acquisition means for dividing said content data into a plurality of data sections on the basis of said free capacity of said storage means computed by said computation means, acquiring a predetermined first data section among said plurality of data sections, and storing said acquired predetermined first data section into said storage means;
generating a second data section smaller in data amount than said first data section, and storing the generated second data section into said storage means; and
deletion means for deleting, when said generated second data section obtained by converting said format of said first data section by said conversion means has been stored in said storage means, said first data section from said storage means before a third data section different from said first data section is acquired by said acquisition means from among said plurality of data sections forming said content data.

The closest prior arts "U.S. Patent No. 5,835,668" and "U.S. Patent Pub. 2003/0194008" fail to anticipate or render the above underlined limitations obvious.

Claims 10-14 are allowable as depending from allowable claim 9.

Claim 16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 16 is considered to be allowed for the same reasons as discussed in claim 9 above.

Claim Objections

1. Claims 1 and 15 are objected to because of the lack of antecedent basis. There is no support for "said Information processing **device**". Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

3. Claims 15 and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 15 and 16 define a program embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed a program can range from paper on which the program is written, to a program simply contemplated and memorized by a person.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,835,668 to Yanagihara.

As to claims 1 and 15, Yanagihara discloses an information processing apparatus comprising:
checking means for checking predetermined time information of content data recorded in a first format (Col. 4 lines 60-67);

setting means for setting, on the basis of said content data time information checked by said checking means, bits rates with which said content data is recorded from said information processing device to a predetermined removable recording medium (Col. 5, lines 4-15; Col. 7, lines, 7-33); and
recording control means for converting the format of said content data from said first format to a second format and recording the converted content data to said recording medium with said bit rates set by said setting means (Fig. 8; Col. 4, lines 60-67, Col. 5, lines 1-15; Col. 9, lines 50-62)

As to claim 2, Yanagihara further wherein said checking means checks a recording time of said content data recorded in said first format as said time information (Col. 4, lines 60-67; Abstract).

As to claim 3, Yanagihara further discloses wherein said content data is constituted by a moving image data and audio data corresponding thereto (Fig. 1; Col. 1, lines 66-67, Col 2, lines 1-6); said setting means sets, as said bit rates, a first bit rate corresponding to said moving image data and a second bit rate corresponding to said audio data (Figs. 1, 5; Col. 1 line 66-67, Col. 2, lines 1-6; Col. 5, lines 4-15; Col. 7, lines, 7-33); and
said recording control means executes control so as to record said moving image data of said content data in said first bit rate set by said setting means and record said audio data in said second bitrate set by said setting means (Fig. 8; Col. 4, lines 60-67, Col. 5, lines 1-15; Col. 9, lines 50-62)

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,835,668 to Yanagihara in view of U.S. Patent Pub. 2003/0194008 A1 to Acharya et al "Acharya"

As to claim 8, Yanagihara as discussed in claim 1 above does not expressly disclose wherein said first format is a format of a digital video tape recorder and said second format is a format specified by the DVD standard.

Acharya discloses wherein said first format is a format of a digital video tape recorder and said second format is a format specified by the DVD standard (Fig. 3; 0001-0002; 0004)

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Yanagihara with the teachings of Acharya. Rationale to combine would have been that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHER KHAN whose telephone number is (571)270-5203. The examiner can normally be reached on 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. K./
Examiner, Art Unit 2621

/Thai Tran/
Supervisory Patent Examiner, Art Unit 2621